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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
10014526-1
(HDP#6215-000039/US)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

Application Number
10/082,245

Filed
February 26, 2002

First Named Inventor
Daniel E. Ford et al.

On _____

Art Unit
2145

Examiner
Jeffrey R. SWEARINGEN

Signature _____

Typed or printed name _____

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages of attachments are provided.

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☐ attorney or agent of record.
Registration number. _____

☒ attorney or agent acting under 37 CFR 1.34.
Registration number: 37,275



Signature

Thomas S. Auchterlonie / Reg. No. 37,275
Typed or printed name

703-688-8000
Telephone number

July 11, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/082,245 Art Unit: 3479
Filing Date: February 26, 2002 Examiner: Jeffrey R. SWEARINGEN
Applicant: Daniel E. FORD et al.
Title: REMOTE INFORMATION LOGGING AND SELECTIVE
REFLECTIONS OF LOGGABLE INFORMATION
Att'y Docket: 10014526-1
(HD Ref. No.: 6215-000039/US)

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Randolph Building
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Alexandria, VA 22314
Mail Stop **AF**

July 11, 2006

ATTACHMENT TO FORM PTO/SB/33
(DETAILS OF PRE-APPEAL BRIEF REQUEST FOR REVIEW)

Sir:

Further to the concurrent filing of the attached Notice of Appeal, the following remarks are submitted in connection with the above-identified patent application under the Pilot Program for Pre-Appeal Brief Conference (Off. Gaz. Patent & Trademark Office, Vol. 1296, No. 2, July 12, 2005).

Claims 1, 4-10, 24-26 and 33-35 are pending.¹ Of these, claims 1, 10 and 24 are independent.

Rejection For Which Conference Is Requested

A Pre-Appeal-Brief Conference is requested to review the rejection² of claims 1, 4-10, 24-26 and 33-35. Appellants disagree with this rejection, for the reasons given previously³, and for the additional reasoning presented below that addresses the Examiner's rebuttal arguments found on page 2 of the Office Action.

¹ Previously, claims 2-3, 11-23 and 27-32 were canceled.

² The statement of rejection spans pages 3-5 of the Office Action (mailed April 11, 2006).

³ See reply by Applicants' filed January 27, 2006, pages 5-9.

More particularly, the rejection begins on page 3 of the Office Action, and is made under 35 U.S.C. §103(a) over U.S. Patent no. 5,857,190 ("the '190 patent") to Brown. For simplicity, this traversal is couched in terms, e.g., of independent claim 1.

On page 4 of the Office Action, the Examiner acknowledges that, while disclosing remote logging, the '190 patent fails to explicitly disclose that logging can be performed locally. However, the Examiner goes on to assert (Office Action page 3, "Brown discloses logging, but ... are logged (column 5, lines 37-40), ... "). Again, this is traversed.

It is helpful to consider what literally is stated in the passages relied by the Examiner. Lines 32-33 from column 7 of the '190 patent are relied upon by the Examiner to support his assertion that the '190 patent "states" that the components of the event system can be distributed over the entertainment network system. Lines 26-33 of column 7 are reprinted as follows.

[Lines 26-32]

A forwarding registry 58 is utilized by the event evaluator 52 to locate the event log manager 56 at the headend, thereby alleviating the need for the event evaluator [52] to know where the log manager 56 is physically and actually residing at the headend. The forwarding [sic, forwarding] registry 58 is shown in the communication path from the user interface unit to the headend.

[Lines 32-33]

It can be is [sic] located at the headend, or have components distributed over the entertainment network system.

In lines 32-33, "it" refers to forwarding registry 58. The above-quoted passage also makes clear that event evaluator 52⁴ uses forwarding registry 58 to locate event log manager 56.⁵

The above-quoted passage, however, does not teach that components in general of the event system can be distributed over the entertainment network system. The Examiner has overestimated the above-quoted passage. Rather, it is limited to being a statement that forwarding registry 58 can have components distributed over the entertainment network system.

Lines 46-53 from column 7 of the '190 patent are relied upon by the Examiner to support his assertion that events can be forwarded to an alternate location. In lines 46-53, the '190 patent teaches that the event information can be forwarded to an entity other than event log

⁴ Again, event evaluator 52 is an entity that is local, i.e., within user interface unit 26, but is not itself a logger of events.

⁵ Again, event log manager 56 is an entity that is remote, i.e., within headend 22, and that itself is a logger of events into log database 62 (which is also located in headend 22).

manager 56. The example given of such another entity is a diagnostic system, which presumably has a location different than the location of the event log manager 56.⁶

Lines 43-45 from column 5 of the '190 patent are relied upon by the Examiner as a teaching of a locally-based event evaluator for screening the events. Inspection of lines 43-45 reveals that event evaluator 52 is concerned merely with whether events are loggable or not. That is, lines 43-45 do not represent a teaching that events are locally logged. This is consistent with Applicants' previous explanation that event evaluator 52 does not perform local logging.⁷

Lines 37-40 from column 5 of the '190 patent are relied upon by the Examiner as a teaching that the operator can configure where the events are actually logged. Lines 30-42 from column 5 are reprinted as follows (underlined emphasis added).

[Lines 30-31]

Loggable events are reported to the headend 22 over the distribution network 28 (step 102).

[Lines 31-37]

The event logging system is designed so that the user interface unit 26 does not need to know the exact location to report the events at the headend [22]. The headend [22] selects an appropriate database to store event information pertaining to the reported events (step 104). An appropriate database is selected based upon the kind of events being logged.

[Lines 37-40]

The event logging system is also designed to permit the operator to configure where the events are actually logged to promote flexibility in resource allocation.

[Lines 40-42]

At step 106, the event information is logged in the selected database, which might be located at the headend [22] or another remote location.

The Examiner's reliance upon lines 37-40 conveniently ignores the succeeding sentence of lines 40-42, which states that the database in which the event information is logged can be located at headend 22 or another remote location. Importantly, lines 40-42 do not merely state

⁶ The statement within lines 46-53, namely "alternatively forward the event information to a location other than the event log manager" (underlined emphasis added) carelessly uses "location" to refer to the other entity. The skilled artisan would have understood that the location is typically different only because the alternate entity is typically going to be found somewhere other than where event log manager 56 is found. The careless statement (contrary to what the Examiner seems to be implying) is not a teaching that event log manager 56 itself can be put in other locations.

that the database can be located at any other location.⁸ Rather, lines 40-42 impose a constraint, namely that the other location at which event information can be logged is a remote location.

EXAMINER'S REBUTTAL

In the Rebuttal Arguments presented on page 2 of the Office Action, the Examiner focuses upon lines 40-42 of column 5, stating (**bold** emphasis in original):

Consideration of context showed that such an alternate logging locating **might** be remote. The skilled artisan would recognize that if a database could be located remotely for storing information, then it could also be located locally.

Essentially the Examiner has omitted the term "another" from his interpretation of the phrase "or another remote location," i.e., he reasons as if the phrase "or another location" had been recited. What context supports the Examiner's revisionist reading of the phrase? It cannot be the preceding sentence of lines 37-40 (again, reprinted above), which merely states that the operator can configure where the events are actually logged. Lines 37-40 teach that there is some flexibility in the selection of where the events are actually logged. But lines 37-40 do not go so far as to be a teaching of there being unbounded flexibility.

The Examiner's rebuttal statement (underlined emphasis added) "if a database could located remotely ..., then it could also be located locally" reveals the impermissible degree to which hindsight is being employed. The standard of obviousness is not what could have been made by the skilled artisan in view of the applied references, but what would have been made.⁹ The skilled artisan would not have omitted the adjective "another" from lines 40-42, i.e., would not have ignored the context. Rather, the skilled artisan would have recognized (from the context) and respected the constraint taught by the '190 patent, namely that any other location for the database must be remote.

If context is not ignored, then the Examiner's obviousness rationale falters. Admittedly, the '190 patent gives a motivation for an alternate logging location, but consideration of context shows that such an alternate logging location must be remote. The '190 patent plainly does not teach that the alternate logging location can be local. As such, a distinction over the '190 patent

⁷ See, the paragraph bridging pages 9-10 of Applicants' Response filed July 28, 2005, which states: "An event evaluator 52 ... in headend 22."

⁸ The use of the adjective "another" also reinforces that headend 22 is at a remote location.

of independent claim 1 is selectively making an entry in a local log. Assuming for the sake of argument that the skilled artisan would have been motivated to adapt the '190 patent in some manner, the result would not have included local logging.

In view of the foregoing discussion, the §103(a) rejection is improper and its withdrawal is requested.^{10, 11}

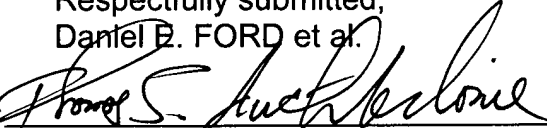
CONCLUSION

In view of the above remarks, Appellants respectfully requests the Pre-Appeal Brief Conference to find in favor of Appellants' positions and arrange for withdrawal of the above-noted rejections.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-2025 for any additional fees under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,
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By



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⁹ See, e.g., MPEP §2143.01(II) ("Fact That Reference Can Be Combined Or Modified Is Not Sufficient To Establish Prima Facie Obviousness").

¹⁰ Independent claim 10 recites a distinction similar to that of claim 1 and thus similarly distinguishes over the '190 patent. Claims 4-9, 24-25 and 33-35 depend from claims 1 and 10 and thus exhibit at least the same distinction, respectively.

¹¹ The § 103(a) rejection of claim 26 (which begins on page 5 of the Office Action) over the '190 patent in view of U.S. Patent No. 6,381,712 to Nemitz ("the '712 patent") also is traversed. Claim 26 depends indirectly from claim 1 and so distinguishes over the '190 patent at least for the same reason as given above regarding claim 1. The '712 patent fails to make up for the shortcomings of the '190 patent. Thus, claim 26 distinguishes over the combination of the '190 patent and the '712 patent.